

REMARKS

Favorable reconsideration of this application is respectfully requested.

Claims 1-59 are pending in the application.

In the outstanding Office Action, claims 1, 5, 6, 17, 20, 24, 25, 36, 38, 39, 43, 44 and 55 were rejected under 35 U.S.C. § 102(e) as anticipated by Yamada (U.S. Patent No. 6,239,837 B1). Claims 19 and 57 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada in view of Nakatani (U.S. Patent No. 5,063,459). Claims 2, 5, 6, 16, 21, 24, 25, 35, 40, 43, 44, and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada in view of Wakui (U.S. Patent No. 5,742,339). Claims 7-9, 11-15, 26-28, 30-34, 45-47 and 49-53 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Yamada and Wakui applied to claims 2, 21 and 40 above and further in view of Yoshiura et al. (U.S. Patent No. 5,854,693, herein "Yoshiura"). Claims 3, 4, 22, 23, 41, and 42 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Yamada and Wakui as applied to claims 2, 21, and 40 and further in view of well known prior art. Claims 18, 37, and 56 were rejected under 35 U.S.C. § 103(a) as unpatentable over Yamada in view of well known prior art. Claims 10, 29, and 48 were rejected under 35 U.S.C. § 103(a) as unpatentable over combination of Yamada, Wakui and Yoshiura as applied to claims 8, 27 and 46 above, and further in view of Ikegaya.

Addressing the above-noted rejections, those rejections are traversed by the present response.

Initially, applicants note the claims are amended by the present response to clarify features recited therein. Specifically, independent claim 1 now recites:

transfer control means for controlling a transfer of the image data between said first and second storing means, the image data including a selection of files, selected by an operator, to be transferred; and

checking means included in said transfer control means for determining, prior to a start of transfer of said image data from said second storing means to said first storing means, whether or not said external storage of said first storage means, which is included in the destination, to which the image data is to be transferred from said second storage means, has a capacity great enough to store said image data of all the files selected by the user to be transferred, the checking means setting a flag when the capacity of said external storage is less than a total capacity of all the files selected by the user to be transferred.

The other independent claims are amended to recite similar features. The claim features are believed to be clear from the discussion in the original specification for example at page 26, line 16 et seq., and see also the discussion at page 30, line 5 et seq. The claims as written are directed to a situation in which an operator selects files to be transferred from, for example, an internal memory to an external memory. As a non-limiting example, if that external memory is a CD-R or a CD-RW, if the capacity of that external memory cannot store all of the files selected to be transferred, that results in not only a wasteful transfer operation, but also inefficiently use of the storing medium, particularly for example in the case of a CD-RW in which data can only be written a certain number of times.¹

Thereby, in the claimed invention before all of the files selected by an operator are to be transferred to the external memory, it is determined whether the capacity of the external memory is enough to record all of the files, and if the external memory does not have a great enough capacity to record all of the files then a flag is set.

Such operations in the claimed invention are believed to clearly distinguish over Yamada, cited as a primary reference in each of the outstanding rejections.

First, Yamada is directed to a different type of device than as claimed. Yamada is directed to a digital camera that allows a copy mode in which data from an internal main memory MM is transferred to an external auxiliary memory card MC. Yamada also discloses that when the external memory MC is attached to the camera data is automatically and

¹ See for example the discussion in the present specification at page 27, lines 15-24.

preemptively stored in that external auxiliary memory MC, and not in the main memory MM in the camera.²

Yamada also appears to disclose an operation in a copy mode in which all of the files in the main memory MM are transferred to the auxiliary memory MC.

That operation in Yamada also differs from the claims as written as in Yamada the operator does not select certain of files to be transferred. That is, in the copy mode in Yamada it appears all of the files from the main memory MM are transferred to the auxiliary memory card MC.

Further, Yamada discloses that when one auxiliary memory card MC is filled up, data from the main memory MM is evacuated into a predetermined inner register until another auxiliary memory card is attached thereto, and then the remaining data is transferred into the another auxiliary memory card MC.³

Such an operation in Yamada also clearly differs from the claims. More specifically, in the claims as written, a determination is made as to whether the external storage has a great enough capacity to store *all of the designated files by the operator prior to the start of the transfer of the image data*. Yamada does not operate in that way. In Yamada all files in the main memory are to be transferred, and if all of those files cannot be transferred in one operation as many files as possible are transferred, and then the remaining files are transferred to a next memory card. The claims do not have such an operation. In the claims if all of the files designated by an operator to be transferred cannot be transferred because of an insufficient capacity of the external memory, then a flag is set. Yamada clearly does not operate in that way.

In such ways, the claims as written are believed to clearly distinguish over Yamada.

² Yamada at col. 9, lines 37-40.

³ Yamada at col. 12, lines 18-39.

Moreover, no teachings in any of the further cited references to Nakatani, Wakui, Yoshiura, or well known art are believed to cure the above-noted deficiencies of Yamada.

With respect to the position of applying "well-known prior art", that basis for the rejection appears to take Official Notice of certain claim features. Applicants traverse that position for Official Notice and require that prior art be cited for such propositions.

In view of the foregoing comments applicants respectfully submit the claims as written distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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